

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the following comments are respectfully requested.

Claims 1 - 14 are pending in the application. Currently, all claims stand rejected.

In the Decision rendered by the Board of Appeals, claims 1 - 14 were rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the Appellant regards as the invention.

The foregoing rejection is traversed by the instant response.

Independent claim 1 is directed to an indenting tool comprising: a shank having a tip end; a diamond affixed to said tip end by a braze material, said diamond forming a point of the tool; and said diamond being mounted to said tip end within 8 degrees of a <17,12,24> direction.

Independent claim 13 is directed to an indenting tool comprising a shank having an end; a diamond secured to said end in a wear resistant orientation; and said wear resistant orientation being within 8 degrees of a <17,12,24> direction.

Independent claim 14 is directed to a method of making an indenting tool, comprising the steps of: providing a shank having an end; providing a diamond; positioning said diamond in a wear resistant orientation; securing said diamond to said end; and said positioning step comprising positioning said diamond in a wear resistant orientation of within 8 degrees of a <17,12,24> direction.

Applicant submits that Applicant has particularly pointed out and distinctly claimed the subject matter which Applicant has regarded as his invention. The rejection is deficient in that the Board has not set forth any facts which would lead one to conclude that Applicant has not particularly pointed out and distinctly claimed the subject matter which he regards as his invention.

The Board's position is based upon the misconception that Applicant's disclosure is somehow deficient. As previously stated one of ordinary skill in the art would know that <17,12,24> refers to 17 units of length in the X direction, 12 units of length in the y direction, and 24 units in the z direction. The <> terminology is standard crystallographic direction terminology which is commonly known to those skilled in the art. Attached hereto is an excerpt from the book The Principles of Engineering Materials by Barrett et al. Please see the section on

crystallographic notation. Also attached hereto is the Declaration of Dr. Dilip Shah, a holder of Ph.D. in Metallurgical Engineering and currently employed as a Fellow in High Temperature Materials. Dr. Shah's declaration confirms the meaning of the terminology <17,12,14> and the fact that one of ordinary skill in the art would readily understand its meaning merely by seeing the terminology used in claims 1, 13, and 14. Dr. Shah's declaration also explains how one of ordinary skill in the art would know to analyze the diamond to find the correct crystal orientation without any undue experimentation. Still further, Dr. Shah concludes that one of ordinary skill in the art, reading the original specification and viewing Figure 3, could make and use the claimed invention without undue experimentation.

With regard to the alignment issue raised by the Board, it should be noted that none of the claims state that the diamond's z-axis is aligned with the shank's tip. Thus, this is a non-issue with respect to the definiteness of the claims currently pending in the application.

Applicant submits that one can make readily understand the claims in the instant application for the purpose of resolving patentability issues. The procedural reversal made by the Board should be withdrawn.

For the foregoing reasons and the reasons of record, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, the Examiner is invited to contact Applicant's attorney at the telephone number listed below.

No fee is believed to be due as a result of this response. Should the Director determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 21-0279.

Respectfully submitted,

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